

## REMARKS/ARGUMENTS

Claims 1-13 are pending herein. Claim 1 has been amended as supported by paragraph [0061] of the present specification, for example and for clarification purposes. Claim 6 has been amended as supported by paragraphs [0061] and [0069] of the present specification and for clarification purposes. Claim 7 has been amended to correct matters of form only. Claims 12 and 13 have been added as supported by paragraph [0058] of the present specification, for example. Additionally, specification paragraphs have been amended to correct matters of form only. Applicants respectfully submit that no new matter has been added.

1. The rejection of claims 1-2, 6 and 8 under §112, second paragraph is noted, but deemed moot in view of the amendments to claims 1 and 6 submitted herewith.

Specifically, the PTO stated that the phrase "corresponding to different configurations of said temporary lens" is vague and indefinite. Claims 1 and 6 have been amended to positively recite a step of successively modifying the temporary lens.

Additionally, the PTO stated that the phrase "obtaining successively optical characteristics" as recited in claims 1 and 6 is vague and indefinite. Claims 1 and 6 have been amended to recite that the same optical characteristic is successively obtained.

With respect to claims 2 and 8, the PTO stated that the phrase "wherein said optical characteristic" is vague and indefinite. Applicants respectfully submit that the amendments to claims 1 and 6 detailed above provide proper antecedent basis for the recitation of "said optical characteristic" in claims 2 and 8.

Further, with regard to claim 6, the PTO stated that the phrase "of said optical system" lacks proper antecedent basis. Claim 6 has been amended to recite an optical system comprising said temporary lens and said schematic eye.

For at least the foregoing reasons, Applicants respectfully submit that claims 1-2, 6 and 8 are in full compliance with §112, second paragraph. Accordingly, Applicants respectfully request that the above rejection be reconsidered and withdrawn.

2. The objection of claim 7 due to a minor editorial informality is noted, but deemed moot in view of the amendment to claim 7 submitted herewith. Accordingly, Applicants respectfully request that the above objection be reconsidered and withdrawn.

3. Claims 1-5 were rejected under §102(b) over Dunn et al. To the extent that this rejection might be applied against the amended claims, it is respectfully traversed.

Claim 1 recites a method of designing an ophthalmic lens including, among other things, applying a temporary lens to a schematic (model) eye such that the temporary lens is located at a position on the schematic eye that corresponds to a stable position on an eye of a wearer in which the ophthalmic lens is held in place.

As supported by paragraph [0058] of the present specification, for example, the temporary lens is located on the schematic eye in a position offset from the optical axis of the schematic eye. The position of the temporary lens on the schematic eye is determined by placing a test lens on the eye of the wearer and determining the stable position of the lens. In other words, the movement of the lens on the cornea of the wearer's eye typically misaligns the optical axis of the eye and the optical axis of the lens. Therefore, it is advantageous to place the temporary lens on the schematic eye in a position that corresponds to the stable position on the wearer's eye, not necessarily the optical axis of the schematic eye, when obtaining optical characteristics.

Dunn discloses a method for designing and making a contact lens wherein an eye model is constructed and a lens with an optic power required by the wearer is placed on the model. An analysis of the lens is performed by tracing light rays through the contact lens/eye system. The PTO argued that the temporary lens will inherently be located at a stable position on an eye of a user. However, Applicants respectfully submit that Dunn does not teach or suggest that the temporary lens is located at a position on the *schematic eye* corresponding to a stable position on an eye of a wearer as recited in claim 1. In fact, in Col. 6, lines 22-23, Dunn specifically states that the lens is placed on the cornea of the eye/model and *centered on the visual axis*.

For at least the foregoing reasons, Applicants respectfully submit that claims 1-5 define patentable subject matter over Dunn and thus are in condition for allowance.

4. Claims 1-5 were further rejected under §102(b) over Seidner. To the extent that this rejection might be applied against the amended claims, it is respectfully traversed.

Claim 1 recites a method of designing an ophthalmic lens including, among other things, applying a temporary lens to a schematic eye and obtaining an optical characteristic of an optical system consisting of the temporary lens and the schematic eye.

Seidner discloses a multi-focal contact lens and method of preparation wherein a diagnostic lens is placed in the wearer's eye and allowed to seat in a natural (stable) position. An over-refraction procedure is then performed to determine the power curve for the lens.

Applicants respectfully submit that Seidner does not teach or suggest that the lens is placed on a schematic eye, or any other external diagnostic apparatus. Seidner, in Col. 5, lines 56-61, specifically states that a diagnostic lens is placed on the patient's eye and an over-refraction is performed to determine the power curve for the lens.

Accordingly, Applicants respectfully submit that claims 1-5 define patentable subject matter over Seidner, and thus are in condition for allowance.

5. Claims 1-11 were rejected under §102(e) over Gordon. To the extent that this rejection might be applied against the amended claims, it is respectfully traversed.

Claims 1 and 6 both recite a method of designing an ophthalmic lens including, among other things, applying a temporary lens to a schematic eye and obtaining an optical characteristic of an optical system consisting of the temporary lens and the schematic eye.

Gordon discloses a method of enhancing visual acuity wherein a series of lenses are placed on the cornea of an eye and the optical correction is thereby

determined. In Col. 4, line 65--Col. 5, line 2, Gordon teaches the process by which the test contact lens is placed on the patient's eye. In Col. 5, lines 6-8, Gordon discloses that the patient is asked to comment on the best lens for the sharpest image.

Applicants respectfully submit that Gordon does not teach or suggest that the lens is placed on a schematic eye or any external diagnostic apparatus. Accordingly, Applicants respectfully submit that claims 1 and 6 define patentable subject matter over Gordon, and thus are in condition for allowance.

Claims 2-5 and 7-11 depend from claims 1 and 6, respectively, which Applicants respectfully submit are in condition for allowance for at least the foregoing reasons. Accordingly, Applicants respectfully submit that claims 2-5 and 7-11 define patentable subject matter over the prior art, and thus are in condition for allowance.

6. Claims 12 and 13 have been added as supported by paragraph [0058] of the specification, for example, and recite that the stable position on the eye of the wearer is determined by an offset amount represented by an angle defined by an intersection of an optical axis of the temporary lens and an optical axis of the schematic eye. The offset amount is determined by averaging a plurality of offset amounts corresponding to different stable positions of a lens on the wearer's eye. When the ophthalmic lens is a contact lens, the offset amount does not exceed 30°.

Applicants respectfully submit that the prior art does not teach or suggest the method of determining an offset amount as recited in claims 12 and 13. Additionally, claims 12 and 13 depend from claims 1 and 6, respectively, which Applicants respectfully submit are in condition for allowance for at least the foregoing reasons. Accordingly, Applicants respectfully submit that claims 12 and 13 define patentable subject matter over the prior art and thus are in condition for allowance.

For at least the foregoing reasons, Applicants respectfully submit that this application is in condition for allowance. Accordingly, the PTO is requested to issue a Notice of Allowance as soon as possible.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,



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Date

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